The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES W. OTTER

Appeal No. 2003-1565
Application No. 09/927,274

ON BRIEF

Before GARRIS, TIMM, and JEFFREY T. SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO EXAMINER

The above identified application is hereby remanded to the examiner via the Office of the Director for Technology Center 3700 for appropriate action consistent with our comments below.

It is well settled that, during patent examination when claims can be amended, the pending claims must be interpreted as broadly as their terms reasonably allow in order to achieve

complete exploration of an applicant's invention and its relationship to the prior art, so that ambiguities can be recognized, the scope and breadth of language explored, and clarification imposed. Thus, the inquiry during examination is patentability of the invention as the applicant regards it, and, if the claims do not particularly point out and distinctly claim the invention, the appropriate PTO action is to reject the claims under the second paragraph of 35 U.S.C. § 112. In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). For the reasons which follow, the record of this appeal does not contain an adequate analysis concerning the critical issue of claim interpretation, as a result of which we are unable to effectively resolve the conflict here raised by the appellant and the examiner.

In the appeal before us, all pending claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Thery. According to the appellant, this rejection is improper because, "[even] [i]f Smith and Thery were combined, the combination would not disclose or suggest applying oxidizable material on both the inner and outer surfaces of a heat exchanger" (brief, page 4) as required by appealed independent claim 1, which is the sole independent claim on appeal. On the

other hand, the examiner argues that lines 39-43 in column 7 of Smith disclose applying a coating of high emissivity material on both sides of patentee's radiator 24 and that "[t]he claimed 'inner' and 'outer' surfaces read just as readily on the opposed sides of radiator 24 of Smith . . . as they do on the opposed sides of heat exchanger 14 of [appellant's] Fig. 4" (answer, pages 5-6). In effect, therefore, on the record of this appeal, the appellant and the examiner have (at least implicitly) expressed contrary interpretations of the independent claim on appeal with the predictable result that the appellant's interpretation favors patentability whereas the examiner's interpretation favors unpatentability.

The mere fact that differing claim interpretations are expressed by the appellant and the examiner would not, by itself, forestall a resolution of this appeal. In this instance, however, we are prevented from effectively resolving this appeal by the additional fact that neither the appellant nor the examiner has supported their respective claim interpretations with the requisite analysis of claim language when read in light of the specification disclosure as it would be interpreted by an artisan with ordinary skill. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed Cir. 1983). In the absence of such

analysis, the propriety of the contrary claim interpretations advanced on this appeal cannot be effectively assessed.

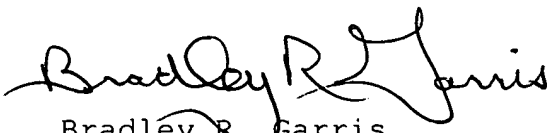
For these reasons, we are constrained to remand this application to the jurisdiction of the Examining Corps so that both the examiner and the appellant can develop the application file record with respect to the issue of claim interpretation. It is, of course, the examiner's initial burden to establish a prima facie case of unpatentability on any grounds. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). It follows that the examiner, upon receipt of this application, must perform the above discussed claim analysis. If the examiner determines that this analysis supports the claim interpretation urged by him on this appeal record, the pending section 103 rejection should be restated along with an explanation of the claim analysis and interpretation which supports such a rejection. If instead the examiner determines that his claim interpretation is not well taken, the pending section 103 rejection should be reconsidered, and indeed the examiner then should consider whether the claims are even capable of a reasonable interpretation pursuant to the second paragraph of 35 U.S.C. § 112.

Whatever rejection, if any, may be made by the examiner as a consequence of this remand and his concomitant claim analysis, the rejection must be made in the forum of reopened prosecution on the merits. Only in such a forum would the appellant be provided with adequate opportunity to respond to the rejection with his own claim analysis and interpretation pursuant to the guidelines previously described. Likewise, only in this forum will the Board be provided with a crystallization of the claim interpretation issue, the present inchoate status of which frustrates our resolution of this appeal.

This application, by virtue of its "special" status, requires an immediate action; see the Manual of Patent Examining Procedure § 708.01(D)(Rev. 1, Feb. 2003). It is important that the Board be promptly informed of any action affecting the appeal in this case.

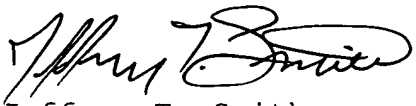
No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REMANDED



Bradley R. Garris
Administrative Patent Judge

Catherine Timm
Administrative Patent Judge



Jeffrey T. Smith
Administrative Patent Judge

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